

REMARKS/ARGUMENTS

Claims 1 and 3-27 are pending in the present application. Claims 1, 21, 24 and 26 were amended in this response to correct minor informalities. No new matter has been introduced as a result of the amendment.

Claims 1, 21, 24 and 26 were objected to for informalities. In light of the present amendments to the claims, Applicants submit the objection has been addressed. Withdrawal of the objection is earnestly requested.

Claims 1 and 3-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Rose et al.* (US Patent 6,396,840) in view of *Ress et al.* (US Patent 6,885,658).

Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Rose et al.* (US Patent 6,396,840) in view of *Cannon et al.* (US Patent 6,735,209). Applicants traverse the above rejections. Favorable reconsideration is respectfully requested.

The cited art, alone or in combination, does not disclose the use of first and second signaling data, respectively coupled to packet-switched and line-switched communications network “wherein the second data is transmitted in the packet-switching communications network instead of the first signaling data when the second signaling data cannot be converted to the first data” as recited in claim 1, and similarly recited in claims 21, 24 and 26.

The Office Action conceded that *Rose* fails to teach the aforementioned limitations. However, the Office Action then erroneously relies upon the teaching of *Ress* to formulate the obviousness rejection. *Ress* discloses interworking agents that communicate with each other according to a protocol independent format referred to as the “agent interworking protocol.” The agent interworking protocol represents a superset of the messaging capabilities of all protocols to be supported within the packet network (col. 6, lines 21-37). The agent networking protocol is used by the system of *Ress* to transfer message data (SIP, MGCP, H.323), and not signaling information, according to a mapped protocol. In col. 9, lines 2-30, *Ress* discloses that the internetworking relates to the protocol of the message (H.323) that is tunneled (i.e., not converted), and not the signaling (H.245). The agent of *Ress* checks to see if the specific signaling is available, and if so, transfers the message data in a converted or native format – if the signaling is not supported, the data is simply discarded (col. 10, lines 35-41).

Furthermore, the present claims recite that the first signaling information is used for packet-switching communication, while the second signaling information is used for line-switching communication. *Ress* is completely silent regarding these features.

Moreover, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Rose* and *Ress* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such

that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

As discussed above, the *Ress* reference the disclosure contemplates the use of an agent interworking protocol to correlate disparate protocols being used across a gateway to ultimately provide a protocol-neutral system. There is simply no teaching, suggestion or motivation for one having ordinary skill in the art to rely on the teaching in *Ress* when considering the teaching of *Rose*. In fact, there is no provision in *Rose* whatsoever that would suggest the use of a protocol-neutral configuration such as that taught in *Ress*. As the other cited references do not solve these deficiencies, the other obviousness rejections must fall as well.

In light of the above, the Applicants respectfully submit that the rejections have been overcome and should be withdrawn. As such, claims 1 and 3-27 of the present application are patentable over the art of record. Therefore, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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